

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

C. RICHARD HUTCHINSON ET AL.

PATENT NO.: 7,427,493

ISSUED: Sept. 23, 2008

FOR: RECOMBINANT GENES FOR POLYKETIDE-MODIFYING ENZYMES

Mail Stop: PETITIONS  
Director, U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PERIOD  
IN GRANTED PATENT UNDER 37 C.F.R. §§ 1.181 & 1.705(d)

Sir/Madam:

This is a request for reconsideration of the patent term adjustment for the captioned patent.

Statement of the Facts

As required under 37 C.F.R. § 1.705(b)(2), Applicant provides the following statement of the facts involved.

The patent term adjustment history from PAIR shows a USPTO delay of 816 days and Applicant's delay of 126 days. These delays were calculated as follows:

*USPTO Delay:*

09-23-2008	PTA 36 Months	343 days
12-16-2005	Mail Restriction Requirement	<u>473 days</u>
		816 days

*Applicant's Delay:*

08-15-2006	Response after Non-Final Action	28 days
08-01-2007	Response after Non-Final Action	15 days
10-23-2007	Response after Non-Final Action	<u>83 days</u>
		126 days

However, as indicated below, the period of USPTO delay for calculating the patent term adjustment should be 1289 days (816 days plus 473 days) minus an Applicant delay of 126 days, resulting in a patent term adjustment of 1163 days.

35 U.S.C. § 154(b) provides for adjustment of patent term due to certain delays of the USPTO. This includes the “A period” of 35 U.S.C. § 1.54(b)(1)(A) (concerning failure of the USPTO to comply with deadlines enumerated therein) and the “B period” of 35 U.S.C. § 1.54(b)(1)(B) (concerning failure of the USPTO to issue a patent within 3 years of filing).

In *Wyeth v. Dudas* (2008 WL 4445642 (D.D.C. September 30, 2008), the United States District Court of the District of Columbia rejected the USPTO’s view<sup>1</sup> that any administrative delay under the “A period” (35 U.S.C. § 154(b)(1)(A) period) overlays any 3-year maximum pendency delay under the “B period” (35 U.S.C. § 154(b)(1)(B) period) (i.e., that applicant gets credit for “A period” or for “B period,” whichever is larger, but never “A period” + “B period”). Rather, the *Wyeth* court held that the “A period” (35 U.S.C. § 1.54(b)(1)(A)) and the “B period” (35 U.S.C. § 1.54(b)(1)(B)) overlap *only* if they occur on the *same calendar day or days*. In view of the *Wyeth* decision, Applicant submits this request for reconsideration of the patent term adjustment period.

In the instant case, the “A period” (35 U.S.C. § 154(b)(1)(A) period) and “B period” (35 U.S.C. § 154(b)(1)(B) period) do not occur on the same calendar day or days. In particular, the 816 day USPTO delay occurring in the “B period” (beginning June 30, 2006, three years after the patent application was filed, and ending on the issue date of September 23, 2008) does not overlap with the 473 day USPTO delay occurring in the “A period” (beginning August 30, 2004 and ending December 16, 2005).

Accordingly, in view of *Wyeth*, Applicant is entitled to the combination of the “A period” (473 days) and the “B period” (816 days), minus the Applicant delay of 126 days, which results in a patent term adjustment of 1163 days. Applicant requests reconsideration of the patent term adjustment period.

The patent is not subject to any terminal disclaimer that would impact such a correction. In addition, Applicants believe there are no additional circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 C.F.R. § 1.704.

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<sup>1</sup> See, 69 Fed. Reg. 34238 (2004).

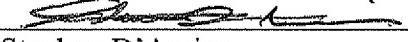
Timeliness of this Request

As this request is being filed within two months of the patent's issue date, it is timely under 37 C.F.R. § 1.705(d).

Request Fee

As required under 37 C.F.R. § 1.705(b)(1), please charge the fee prescribed in 37 C.F.R. § 1.18(e) to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company. Please charge any additional fees, or credit any overpayment, to the same account.

Bristol-Myers Squibb Company  
Patent Department  
P.O. Box 4000  
Princeton, NJ 08543-4000

  
Stephen D'Amico  
Attorney for Applicants  
Reg. No. 46,652  
Phone No. (609) 252-5289

Date: 10-29-08